

FHFGD Docket No. 3804.0128

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In. re Reissue Application of
U.S. Patent No. 5,856,121 to
Gorski et al

Serial No.: 09/755,320

Filed: January 5, 2001

For: Growth Arrest Homeobox Gene

Attorney Docket Number: 22311/04013

) Prior Application
)
) Group Art Unit: 1812
)
) Examiner: C. Saoud
)

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TECH CENTER 1600/2900

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

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OFFICE OF PETITIONS

DECLARATION IN SUPPORT OF SUBMISSION OF INFORMATIONUNDER 37 C.F.R. § 1.56

I, Pamela A. Docherty, am a registered patent attorney employed at the law firm of Calfee, Halter & Griswold LLP ("CHG"). Recently, it was brought to my attention that a former employee, Keith Baker, in the Legal Department at Rhône-Poulenc Rorer ("Rhône-Poulenc"), the licensee for the instant application and U.S. Patent No. 5,856,121 was barred, pursuant to 37 C.F.R. §10.10(b), from assisting in any manner in the preparation or prosecution of certain patent applications. The following, which is based on my recollections and documents in our law firm's files, is a description of my interactions with Mr. Baker in connection with U.S. Patent Application Ser. No. 08/203,532 (hereinafter "Application '532"), now U.S. Patent No. 5,856,121.

In 1994, our client, the Edison BioTechnology Center ("Edison BioTech"), a non-profit organization for promoting biotechnology in the state of Ohio, hired our law firm to prepare and prosecute Application '532 on behalf of Case Western Reserve University ("Case Western"), the assignee of the inventions disclosed therein. Mary E. Golrick, another registered patent attorney

at our law firm, prepared, filed and was involved in prosecution of Application '532. I began assisting Ms. Golrick in connection with Application '532 in September, 1994.

In the summer of 1995, our client, Edison Biotech, informed us that Application '532 had been licensed to Rhône-Poulenc. In August, 1995, we received instructions from Edison BioTech and Case Western, the assignee of Application '532 to send all correspondence that was received from or sent to the U.S. Patent and Trademark Office ("PTO") to Mr. Martin Savitzky, Vice President of Patents at Rhône-Poulenc, for his review and any comment he might have. Accordingly, we sent the second Office Action (mailed May 24, 1995) for Application '532 and supporting documents which Ms. Golrick and I had already prepared in response to the second Office Action to Mr. Savitzky. We received a letter, dated September 19, 1995, from Mr. Savitzky in which he proposed certain minor changes to the Amendment and the supporting documents. We incorporated some, but not all, of Mr. Savitzky's proposed revisions into our response.

In September of 1996, I received a telephone call from Mr. Keith Baker, who informed me that he was a patent agent at Rhône-Poulenc. Indicating that he was calling me at Mr. Savitzky's request, Mr. Baker asked me to send him a copy of the response which we had filed with the PTO on July 30, 1996, for Application '532. I continued communicating by mail with Mr. Savitzky throughout the prosecution of Application '532, i.e., until payment of the issue fee in December of 1997. However, on at least one occasion in the summer of 1997, I recall receiving a telephone call from Mr. Baker, during which he told me that Mr. Savitzky had reviewed an Amendment which our office had prepared in response to a Final Office Action, but had no comments. During our conversation, I believe that Mr. Baker commented that the Amendment After Final probably would not be entered in the case because it raised new issues that would require further consideration and/or search. I believe that Mr. Baker also mentioned that he had been a patent examiner in the PTO. However, Mr. Baker did not provide me with any further details about his employment at the PTO.

Subsequent to payment of the issue fee, i.e., December, 1997, we sent copies of a Status Letter, soft copies of the patent, and a Certificate of Correction for Application '532 to Mr. Baker. It was my understanding from Mr. Baker that he was to act as our contact at Rhône-

Poulenc, and that he would either route these documents to Rhône-Poulenc's files for Application '532 or, if necessary, bring them to Mr. Savitzky's attention.

SUMMARY

I was not aware of the time period during which Mr. Baker had been a patent examiner at the PTO. I was not aware of the Art Unit in which Mr. Baker had served as an Examiner. During the time period that Mr. Baker acted as the contact between our law firm and the legal department at Rhône-Poulenc, I also was not aware that Mr. Baker was barred, pursuant to 37 C.F.R. §10.10, from "assist[ing] in any manner" on Application '532. It was not until December, 2000, when a representative of our client, Edison Biotech, contacted me about this matter that I became aware that Mr. Baker, as a former patent examiner, was barred under 37 C.F.R. §10.10 with respect to the instant case.

Date: May 2, 2001

By: Pamela A. Docherty
Pamela A. Docherty, Reg. No. 40,591

Calfee, Halter & Griswold LLP